

Appln No. 10/734,517

Amdt date March 23, 2005

Reply to Office action of December 23, 2005

REMARKS/ARGUMENTS

Claims 1-4 and 6-26 are in the present application, of which claims 1, 2, 14, 18 and 25 are independent. Claim 5 has been canceled herein without prejudice. Claims 2, 4, 6 and 14 have been amended herein. Applicants request reconsideration and allowance of claims 1, 4, 11-12 and 14-17¹ in addition to the allowed claims 18-23 and allowable claims 2 and 3, which are rewritten herein in allowable form. In addition, applicants request that claims 6-10 and 13 be maintained as allowable, and be allowed as depending from claim 1. Further, applicants request consideration on the merits and allowance of newly added claims 24-26.

Applicants thank the Examiner for the time and courtesy extended to applicants' attorney during the telephone interview of February 16, 2005. During the telephone interview, claim 1 was discussed in reference to U.S. Patent No. Re 28,752 ("Balamuth II"). In particular, applicants' attorney pointed out the differences between the retaining ring of the present invention and what the Examiner appears to consider to be an equivalent structure in Balamuth II. However, no agreement has been reached.

¹ Claims 15 and 16, which the Examiner previously indicated as allowable, depend from claim 14 as amended, and are now not identical to the form which the Examiner has previous considered because of their dependency on the amended claim 14.

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I. Rejection of Claims 1, 4, 11, 14 and 17 under 35 U.S.C.

§102(b)

Claims 1, 4, 11, 14 and 17 have been rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Balamuth II. In rejecting claims 1, 4, 11, 14 and 17, the Examiner states that "Balamuth shows an ultrasonic dental insert comprising a transducer, a tip 66, a connecting body 75 disposed between and attached to the transducer and the tip, a retaining ring 81 snapped onto the connecting body, and a hand grip 52 fitted at least partially over the connecting body and retaining ring." As to claim 11, the Examiner further states that "the O-ring 110 [is] located in a groove 109 in the connecting body." As to claims 14 and 17, the Examiner contends that "the method of assembling an ultrasonic dental insert is inherently carried out when the insert of Balamuth is put together."

What the Examiner refers to as the "retaining ring 81" in the Office Action is an O-ring, as illustrated in FIG. 4 of Balamuth II and described on column 7, lines 5-11, for example. O-rings are typically used for sealing so as to prevent fluid from escaping. By their nature, O-rings are not structural parts. They have to be supported by a structural part in order to accomplish this sealing function. The retaining ring is a structural part, which can be adapted for supporting an O-ring. Thus, the retaining ring in exemplary embodiments of the present invention is vastly different from the O-ring 81 of Balamuth II. There is no teaching in Balamuth II of this structural part.

To anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal*

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Bros. v. Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Therefore, all claim elements, and their limitations, must be found in the prior art reference to maintain a rejection based on 35 U.S.C. §102. Applicants respectfully submit that Balamuth II does not teach every element of claim 1, as the O-ring in Balamuth II is not a retaining ring which is a structural part. Therefore, Balamuth II fails to anticipate claim 1, and applicants request that the rejection of claim 1 be withdrawn and that it be allowed.

Since claims 4 and 11 depend from claim 1, they each incorporate all the terms and limitations of claim 1 in addition to other limitations, which together further patentably distinguish them over the cited references. Therefore, applicants request that the rejection of claims 4 and 11 be withdrawn and that they be allowed.

Claim 14 has been amended to clarify one of the distinctions between the retaining ring of the present invention and an O-ring, and now it recites, in a relevant portion, "[a] method of assembling an ultrasonic dental insert comprising . . . snapping the retaining ring onto the connecting body, the retaining ring having a hole formed on its surface, adapted for passing fluid into the ultrasonic dental insert . . ." (Emphasis Added).

First of all, claim 14 is not anticipated by Balamuth II because O-ring 81 of Balamuth II does not have any such hole on its surface. Further, as any formation of a hole on a surface of an O-ring is likely to defeat its sealing purposes, "the retaining ring having a hole formed on its surface" would not even have been obvious at the time of the present invention over Balamuth II,

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either individually or in any combination with other cited references.

Since Balamuth II does not disclose such an ultrasonic dental insert as recited in claim 14, claim 14 is not anticipated by Balamuth II. Therefore, applicants request that the rejection of claim 14 be withdrawn and that it be allowed.

Since claim 17 depends from claim 14, it incorporates all the terms and limitations of claim 14 in addition to other limitations, which together further patentably distinguish it over the cited references. Therefore, applicants request that the rejection of claim 17 be withdrawn and that it be allowed.

II. Rejection of Claim 12 under 35 U.S.C. §103(a)

Claim 12 has been rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 3,809,977 (Balamuth I) in view of U.S. Patent No. 3,654,502 ("Carmona et al."). As Balamuth II is a reissue of Balamuth I, Balamuth I has substantially the same disclosure as Balamuth II. As such, Balamuth I does not disclose any retaining ring which is a structural part. Further, Carmona et al. is cited for the proposition that it "shows an ultrasonic tool wherein the transducer comprises a stack of nickel plates 22p." Therefore, Balamuth I and Carmona et al. do not teach or suggest "a retaining ring snapped onto the connecting body " as recited in claim 1.

Since claim 12 depends from claim 1, it incorporates all the terms and limitations of claim 1 in addition to other limitations, which together further patentably distinguish it over the cited references. Therefore, applicants request that the rejection of claim 12 be withdrawn and that it be allowed.

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III. Allowable Subject Matter

Applicants appreciate the allowance of claims 18-23, and request that their allowance be maintained.

Claims 2, 3, 5-10, 13, 15 and 16 have been objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Since claim 2 has been rewritten in independent form including all of the limitations of claim 1, applicants request that the objection to claim 2 be withdrawn and that it be allowed. Since claim 3 depends from claim 2, applicants request that claim 3 be allowed as well.

Since claim 5 has been canceled herein, any objection to claim 5 is now moot.

Since claims 6-10 and 13 have not been amended herein, applicants request that their allowability be maintained. Further, since claims 6-10 and 13 depend, directly or indirectly, from claim 1, they each incorporate all the terms and limitations of claim 1 in addition to other limitations, which together further patentably distinguish them over the cited references. Therefore, applicants request that the objection to claim 6-10 and 13 be withdrawn and that they be allowed.

Since claims 15 and 16 depend, directly or indirectly, from claim 14, they each incorporate all the terms and limitations of claim 14 in addition to other limitations, which together further patentably distinguish them over the cited references.

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Therefore, applicants request that the objection to claim 15 and 16 be withdrawn and that they be allowed.

IV. New claims 24-26

Since claim 24 depends from claim 13, it incorporates all the terms and limitations of claims 1 and 13 in addition to other limitations, which together further patentably distinguish claim 24 over the cited references. Therefore, applicants request that the newly added claim 24 be allowed.

Claim 25 recites, in a relevant portion, "[a]n ultrasonic dental insert comprising. . . a retaining ring snapped onto the connecting body, the retaining ring having a hole formed on its surface, adapted for passing fluid into the ultrasonic dental insert." (Emphasis Added) For the reasons similar to those given above in reference to claim 14, new claim 25 is patentably distinguishable over the art of record. Therefore, applicants request that claim 25 be allowed.

Since claim 26 depends from claim 25, it incorporates all the terms and limitations of claim 25 in addition to other limitations, which together further patentably distinguish claim 24 over the cited references. Therefore, applicants request that the newly added claim 26 be allowed.

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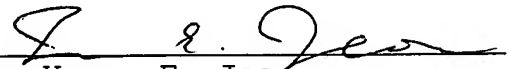
V. Concluding Remarks

In view of the foregoing amendments and remarks, applicants respectfully request an early issuance of a patent with claims 1-4 and 6-26. If there are any remaining issues that can be addressed over the telephone, the Examiner is invited to call applicants' attorney at the number listed below.

Respectfully submitted,

CHRISTIE, PARKER & HALE, LLP

By



Jun-Young E. Jeon

Reg. No. 43,693

626/795-9900

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